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Xerox Docket No. D/98389

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Gene M. Nitschke

Group Art Unit: 2173

Application No.: 09/411,642

Examiner: C. Thai

Filed: October 4, 1999

Docket No.: 103045

For: METHOD AND SYSTEM TO ESTABLISH DEDICATED INTERFACES FOR THE
MANIPULATION OF SEGMENTED IMAGES

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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JAN 4 -- 2005

Technology Center 2100

Sir:

In reply to the November 2, 2004, Office Action, Applicant respectfully requests that the Appeal in this case be reinstated, or that the case be allowed, upon consideration of the following remarks.

Claims 1-21 are pending in this application.

The Office Action rejects claims 1-3, 6, 9-14, 16 and 21 under 35 U.S.C. §103(a) over U.S. Patent No. 5,787,194 to Yair, in view of U.S. Patent No. 6,341,183 to Goldberg. The Office Action rejects claims 4, 5, 15 and 20 under 35 U.S.C. §103(a) over Yair in view of Goldberg and further in view of U.S. Patent No. 5,710,877 to Marimont et al. (hereinafter "Marimont"). The Office Action rejects claims 7, and 17-18 under 35 U.S.C. §103(a) over Yair in view of Goldberg and further in view of U.S. Patent No. 6,026,182 to Lee et al. (hereinafter "Lee"). The Office Action rejects claims 8 and 19 under 35 U.S.C. §103(a) over Yair in view of Goldberg and further in view of U.S. Patent No. 6,009,196 to Mahoney. These rejections are respectfully traversed.

The rejections set forth in the present Office Action are substantially identical to those set forth in the Final Rejection, mailed June 3, 2002, from which an Appeal was lodged on October 3, 2002. Following the review of the Appeal Brief filed on November 21, 2002, the Examiner's Answer on February 11, 2003 and the Reply Brief filed March 28, 2003, the Board of Patent Appeals and Interferences remanded the case to the Examiner on August 3, 2004, with the instructions that "If reconsideration by the examiner does not result in the prompt withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the Board so that appeal may be restored." Applicant submits that the present Office Action is improper, as it does not comply with the instructions from the Board of Patent Appeals and Interferences.

In a December 14 telephone conference with Examiner Cabeca, Applicant's representative requested that the present rejection be withdrawn, and that the Appeal be reinstated. Examiner Cabeca agreed that the present rejection was similar to the previous Final Rejection, and indicated that the present Office Action was issued to correct an error in the previous Final Rejection. Examiner Cabeca declined to withdraw the Office Action.

A comparison of the present rejection with the previous Final Rejection reveals that the only substantive change in the present rejection is that the Examiner now agrees that Yair does not disclose "a system that assembles a dedicated user interface." However, the Office Action still relies on Goldberg to supply the missing subject matter, and uses substantially the same (improper) motivation to combine the references. As far as the motivation to combine the references, the Office Action merely states that "It would have been obvious" because "By doing so, the system would be enhanced by providing a GUI-based tools to an end user wherein the end user can performing [sic] editing, manipulating and controlling of image acquisition system based on user's desired manner and the system would providing [sic] real-time data analysis support for images acquired during the alignment of the image acquisition apparatus." Applicant submits that this "motivation" is nothing more than a conclusory statement regarding what would

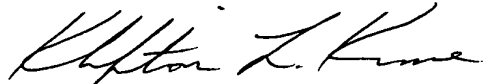
happen if the references were to be combined, and nowhere in either Yair or Goldberg is a motivation to combine the references expressed.

As repeatedly argued in the Requests for Reconsideration, Appeal Brief, and Reply Brief, Yair does not need, nor can Yair use, the system of Goldberg to provide "GUI-based tools" or "real-time data analysis support for images." Accordingly, the present Office Action, as well as the Final Rejection, fails to make out a prima facie case of unpatentability of the claims.

Proper motivations to combine the other references, including Marimont, Lee and Mahoney are similarly lacking, as argued in the previous Requests for Reconsideration, Appeal Brief and Reply Brief.

In view of the foregoing, it is respectfully requested that the Examiner return this application to the jurisdiction of the Board of Patent Appeals and Interferences, so that the Appeal may be restored, or pass this case to issue. Further, Applicant requests that the Board provide favorable consideration on appeal, notwithstanding the improper attempt by the Examiner to introduce new grounds of rejections, contrary to the express instructions of the Remand from the Board of Patent Appeals and Interferences.

Respectfully submitted,



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JAO:KLK/kzb

Date: December 23, 2004

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